APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,805	09/26/2000	Scott C. Harris	RTA/SCH	3717

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SCOTT C HARRIS
P O BOX 927649
SAN DIEGO, CA   92192

EXAMINER
FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
3679	

3

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Offic Acti n Summary	09/669,805	HARRIS, SCOTT C.
	Examiner	**Art Unit**
	Ryan M Flandro	3679

-- The MAILING DATE of this communication appears on th c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *26 September 2000* is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Drawings

1.   New corrected drawings are required in this application because they are informal and, to

some extent, incomprehensible. Applicant is advised to employ the services of a competent

patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer

prepares new drawings. The corrected drawings are required in reply to the Office action to

avoid abandonment of the application. The requirement for corrected drawings will not be held

in abeyance.

Claim Objections

2.   Claims 3-6, 9-17, and 19-21 are objected to because of the following informalities:

a.   Claims 3-6, 9-12, 14-17, and 19-21. Each dependent claim should begin with the

word "The" rather than the word "A" in order to properly refer back to the claim from

which each depends.

b.   Claim 13. The word "amounts" in line 4 of the claim should be in singular form

("amount").

c.   Appropriate correction is required.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
requirements of this title.

4.   Claims 1, 7, 8, 10-17, and 21 are rejected under 35 U.S.C. 101 for the following reasons:

a.   First, no technology is recited in the body of claims 1, 7, 8, and 10-17. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (CAFC 1998) (holding that claim directed to machine programmed with data processing software for administering investment structure produces useful, concrete, and tangible result, and therefore constitutes statutory subject matter.). The Examiner notes that the specification and several of the claim preambles provide support for implementing technology and, as such, Applicant is advised that this technology should be recited in the body of the claims in order to overcome this rejection.

b.   Second, claims 1, 7, 11, 13-17, and 21 recite a "user," "person," or "participant" as a limitation. Recitations of humans as part of an apparatus or system are considered non-statutory.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown (US

5,794,219).

> a. Claim 1. Brown clearly discloses a method of forming a bidding auction over a
>
> remote information server, comprising allowing each of a plurality of users **38** to view a
>
> current bid **68** and place a new bid **62** for an item in an auction; and automatically
>
> updating a view seen by at least some of said plurality of users to reflect a change in a
>
> current highest price on said item, without requiring an action by said some of said
>
> plurality of bidders for said updating. (*See* figures 2 and 9; column 6 line 53 – column 8
>
> line 18; *see specifically* column 8 lines 12-18 – "Specific techniques of updating browser
>
> **29** in this manner are well known in the art.")
>
> b. Claim 7. Brown discloses a method of conducting an auction on the Internet,
>
> comprising conducting a first portion of the auction in a mode where users view an item,
>
> and a price for the item, in an noninteractive manner (see figures 6; column 6 line 53 –
>
> column 7 line 46); and conducting a second portion of the auction in an interactive
>
> manner, in which the auction participants place real time bids, which real time bids are
>
> seen automatically by other participants in the auction (figure 9; column 7 line 47 –
>
> column 8 line 59).

7.   Claims 2-6, 8-16, 18, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated

by Ausubel (US 5,905,975).

a. Claim 2. Ausubel clearly discloses a method of bidding on an auction over a remote information server, comprising placing a bid in an auction over a remote information server; and defining a time profile for the bid, where the time profile specifies at least one amount of a bid to be set at a specified time in the auction other than a current time (see column 1 line 61 – column 3 line 67).

b. Claim 3. Ausubel further discloses a method wherein said time profile comprises a plurality of maximum bids which are allowed at a plurality of specified times (see column 1 line 61 – column 3 line 67).

c. Claim 4. Ausubel further discloses a method wherein said specified time is measured relative to a scheduled auction end time (see column 1 line 61 – column 3 line 67).

d. Claim 5. Ausubel further discloses a method wherein said bids are provided to an agent program (see top of column 3 – "intelligent systems…auctioneer's system"), which keeps the amounts of the bids secret (see column 1 lines 63-64 "combining some of the advantageous facets of the sealed-bid format…") until a time that is specified by the bid (see generally column 2).

e. Claims 6. Ausubel further discloses a method wherein said agent stores locally, on a users bidding terminal, certain amounts which facilitate accepting or rejecting bids without contacting a remote server (see column 6 lines 31-37).

f. Claim 8. Ausubel further discloses a method of automated auction bidding comprising storing, for a specified auction, a plurality of bids, and a plurality of times when those bids are to be released, respectively; and automatically placing each of said bids at said time associated with said bid (column 1 line 61 – column 3 line 67).

g. Claim 9. Ausubel further includes a method comprising conducting said auction on a server, and storing certain information about said auction on a client that is accessing said server, and further comprising enabling certain bids to be rejected, without accessing said server, using only information stored on said client (see column 6 lines 31-37).

h. Claim 10. Ausubel further includes a method where each of said plurality of bids are stored as rules, each rule being kept secret until a time of a bid, and each bid being released at said time (see column 1 line 61 – column 3 line 67).

i. Claim 11. Ausubel further discloses a method comprising checking an identification of a person making the bid (see column 6 lines 46-47).

j. Claim 12. Ausubel further discloses a method further comprising enabling placing a quick bid, which automatically provides a bid that is high enough to win a current bidding situation (see column 1 line 61 – column 3 line 67; see also example at column 10 line 39 – column 12 line 19 - in the example, the automated system containing bidder 1's bidding rules automatically places bids high enough to win current bidding situations depending on the particular auction circumstances).

k. Claim 13. Ausubel further discloses a method of automated auction bidding, comprising allowing a plurality of users to bid on an item, where one of the plurality of users has a highest bid, and at least one other of the plurality of users can bid an amount that exceeds said highest bid; and enabling a quick bid function whereby a user can automatically bid an amount which will win the auction, said amount being an amount sufficiently high to overcome all existing bids (see column 1 line 61 – column 3 line 67; see also example at column 10 line 39 – column 12 line 19 - in the example, the

automated system containing bidder 1's bidding rules automatically places bids high

enough to win current bidding situations depending on the particular auction

circumstances).

l.   Claim 14. Ausubel further discloses a method wherein there are a plurality of bids,

some of which are known and others of which are secret, and wherein said quick bid only

overcomes those bids which are known (see column 1 line 61 – column 3 line 67; see

also example at column 10 line 39 – column 12 line 19).

m.   Claim 15. Ausubel further discloses a method wherein said plurality of bids includes

a plurality of bids, associated with times when those maximum bids can be made, and

only those bids whose times have been reached are known (see column 1 line 61 –

column 3 line 67; see also example at column 10 line 39 – column 12 line 19).

n.   Claim 16. Ausubel further discloses a method further comprising enabling an action

which allows determining both secret bids and non secret bids (see column 1 line 61 –

column 3 line 67; see also example at column 10 line 39 – column 12 line 19 – in the

example, the automated system performs queries which determine both secret and non-

secret bids according to the rule profile).

o.   Claim 18. Ausubel further discloses a system, comprising a server running a program

that displays information about an item to be auctioned, and accepts bids on said item,

and keeps track of a maximum bid; and a client, sending a bid to said server which

includes an amount of a bid, and a time when said bid should be placed, wherein said

time is other than a present time (see column 1 line 61 – column 3 line 67).

p. Claim 20. Ausubel discloses a system wherein said client allows sending a plurality

of bids, to be executed at a plurality of times (see column 1 line 61 – column 3 line 67).

q. Claim 21. Ausubel further discloses an amount of said quick bid being displayed

responsive to a specified action by the user (e.g., inputting the bid on the bid sheet

displayed on user's system) (see column 1 line 61 – column 3 line 67).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ausubel, as applied

to claim 16 above, in view of Woolston (US 6,202,051). Ausubel lacks explicit disclosure that

said action includes an extra fee beyond that which would be charged for only non secret bids.

Woolston, however, teaches that it is well known in the art to include fees charged for various

actions in the auction setting (see specifically claims 29 and 30). Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to include an

extra fee beyond that which would be charged for only non-secret bids since it is well known in

online auctions to charge for various actions associated with an auction as taught by Woolston.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ausubel, as applied

to claim 18 above, in view of Brown, as applied above. Ausubel lacks explicit disclosure of a

system wherein said server automatically updates at least one screen being seen on at least one

client to automatically show new bid amounts. Brown, however, clearly teaches a system

wherein said server automatically updates at least one screen being seen on at least one client to

automatically show new bid amounts (*See* figures 2 and 9; column 6 line 53 – column 8 line 18;

see specifically column 8 lines 12-18 – "Specific techniques of updating browser **29** in this

manner are well known in the art."). Therefore, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to include the feature wherein the

server automatically updates the bid amounts shown on at least one screen being seen on at least

one client so that the client is consistent with the current auction situation as taught by Brown.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to

overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this

application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37

CFR 3.73(b).

12. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 13, 14, 15, 18, 19, and 20 are provisionally rejected under

the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 14, 5, 7, 6, 8, 5 and 9, 1 and 22, 5, 5 and 9, 5, 13, 13 and 8, 13 and 8, 10, 11, and 10,

respectively, of copending Application No. 09/780,248. Although the conflicting claims are not

identical, they are not patentably distinct from each other because they recite the same

limitations including, *inter alia*, automatically updating remote system displays and defining

rules or time profiles for automatically placing bids at different times during the auction. This is

a provisional double patenting rejection since the conflicting claims have not yet been patented.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. The following patents are cited to further show the state of the art with respect to

internet auction systems:

      U.S. Patent 6,415,269 to Dinwoodie

      U.S. Patent 6,243,691 to Fisher et al.

      U.S. Patent 6,161,099 to Harrington et al.

U.S. Patent 6,044,363 to Mori et al.

U.S. Patent 6,026,383 to Ausubel

U.S. Patent 6,023,686 to Brown

U.S. Patent 6,021,398 to Ausubel

U.S. Patent 5,890,138 to Godin et al.

U.S. Patent 5,835,896 to Fisher et al.

U.S. Patent 4,789,928 to Fujisaki

Canadian Patent Application Pub. 2305834 to Snider

14. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The

examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9326 for regular

communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-1113.

RMF
July 8, 2003

ERIC K. NICHOLSON
PRIMARY EXAMINER

Greg Binda
Primary Patent Examiner
Technology Center 3670